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10/720,825	11/24/2003	Craig L. Reding	03-1025	5353

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EXAMINER	
PHAN, HUY Q	
ART UNIT	**PAPER NUMBER**
2617	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/720,825	REDING ET AL.	
	Examiner	Art Unit	
	HUY PHAN	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 November 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9,10,12,13,16 and 17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9,10,12,13,16 and 17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/19/2009 has been entered.

Response to Amendment

2. This Office Action is in response to Amendment filed on date: 11/19/2009.

Claims 1-7, 9, 10, 12, 13, 16 and 17 are still pending.

Claim 8, 11, 14 and 15 have been cancelled.

Response to Arguments

3. It is noted that applicant has amended claims and the new ground(s) of rejection is newly presented. Since, Packham and Karve references are still used for the rejection, therefore the examiner addresses each and every applicant's argument and explains why the cited references can be used for the rejection.

Applicant's arguments, see REMARKS, have been fully considered but they are not persuasive.

Applicant argued that "KARVE and PACKHAM et al. do not disclose or suggest identifying, by the server device, a second device of the plurality of devices as a preferred device instead of the first device (to which an SMS message is addressed) to receive the SMS message based on information stored by the receiving party at the server device, where the second device is identified without sending the SMS message to the first device" (see REMARKS page 9). The examiner respectfully disagrees with the applicant's argument. Figure 1 and paragraph [0019] of Packham disclose a server device (fig. 1, SMSC-SMS/GMSC and [0019]) for use in the forwarding a SMS message ("a short message service centre SMSC forwards a text message" see [0019]). Packham describes that the server device identifies the preferred device by interrogating the routing information ("interrogates… routing information thereto" see [0019]) and then using the provided routing information ("using the routing information" see [0019] and fig. 1, handset 3) to forward a SMS message to a preferred device (fig. 1, handset 3; see [0019]) instead of a first device (fig. 1, handset 2; see [0019]) and ("the usual path of the text message to the user terminal 2 is replaced by the path of the text message to the user terminal 3" see [0019]). Karve discloses a server device for use in the forwarding a SMS message ("forward the message to multiple destinations… the SMS" see [0032]). Karve discloses that the routing information can be stored by the receiving party at the server device ("allowing the user to define forwarding address lists stored at the SMS center" see [0030]). Consequently, the combination of Packham and Karve discloses each and every claimed limitation of "identifying, by the server device, a second device of the plurality of devices as a preferred device instead of the first device

to receive the SMS message based on information stored by the receiving party at the server device, where the second device is identified without sending the SMS message to the first device"

It is believed that the cited references Packham and Karve disclose all the limitations of independent claim 1 (see examiner's explanation in above sections). Thus the combination of cited references Packham, Karve and Gopinath can be used to reject dependent claim 3, because the combination of cited references teaches each and every claimed limitation.

It is believed that the cited references Packham and Karve disclose all the limitations of independent claim 1 (see examiner's explanation in above sections). Thus the combination of cited references Packham, Karve and Dehlin can be used to reject dependent claim 4, because the combination of cited references teaches each and every claimed limitation.

It is believed that the cited references Packham and Karve disclose all the limitations of independent claim 1 (see examiner's explanation in above sections). Thus the combination of cited references Packham, Karve and Sabo can be used to reject dependent claim 5, because the combination of cited references teaches each and every claimed limitation.

It is believed that the cited references Packham and Karve disclose all the limitations of independent claims 1 and 9 (see examiner's explanation in above sections). Thus the combination of cited references Packham, Karve and Fostick can be used to reject dependent claims 7 and 10, because the combination of cited references teaches each and every claimed limitation.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12 and 16 rejected under 35 U.S.C. 102(e) as being anticipated by Packham (US 2003/0055906; previously cited).

Regarding claim 12, Packham discloses an apparatus (fig. 1, SMSC-SMS/GMSC and [0019]) to provide short message service (SMS) messages to a user ("people with two handsets" see [0021]) associated with a plurality of devices (fig. 1, handsets 2 and 3; see [0019]), comprising:

means for storing a specification of a preferred device ("using the routing information" see [0019] and fig. 1, handset 3);

means for receiving a SMS message ("a short message service centre SMSC forwards a text message" see [0019]) identifying one device of the plurality of devices ("using the routing information" see [0019] and fig. 1, handset 3);

means for selecting the preferred device ("using the routing information" see [0019] and fig. 1, handset 3) instead of the identified one device for receiving the SMS message in response to receiving the SMS message ("the usual path of the text message to the user terminal 2 is replaced by the path of the text message to the user terminal 3" see [0019]), the preferred device being different than the identified one device (fig. 1, handset 2 and see [0019]), where the preferred device is identified without sending the SMS message to identified one device ("the usual path of the text message to the user terminal 2 is replaced by the path of the text message to the user terminal 3" see [0019]); and

means for sending the SMS message to the preferred device ("a short message service centre SMSC forwards a text message" see [0019]), the means for sending the SMS message comprises means for formatting the SMS message in accordance with characteristics of the preferred device before sending the message to the preferred device ("short message… mobile handset" see [0019] and "a computer… text messages received via email" see [0022]), where the means for sending the SMS message employs a pathway to the preferred device does not include the identified one device ("the usual path of the text message to the user terminal 2 is replaced by the path of the text message to the user terminal 3" see [0019]).

Regarding claim 16, Packham discloses a method, performed by a network routing device (fig. 1 and [0019]), the method comprising:

receiving a short message service (SMS) message ("a short message service centre SMSC forwards a text message" see [0019]) including information identifying a first destination device (fig. 1, handset 2 and see [0019]);

identifying a second destination device (fig. 1, handset 3) instead of the first destination device for receiving the SMS message in response to receiving the SMS message ("the usual path of the text message to the user terminal 2 is replaced by the path of the text message to the user terminal 3" see [0019]), the second destination device being different than the first destination device (fig. 1, handsets 2 and 3; see [0019]), where the second destination device is identified without sending the SMS message to the first destination device ("the usual path of the text message to the user terminal 2 is replaced by the path of the text message to the user terminal 3" see [0019]);

formatting the SMS message based on the second destination device ("short message… mobile handset" see [0019] and "a computer… text messages received via email" see [0022]); and

sending, via a pathway that does not include the first destination device, the formatted SMS message to the second destination device ("the usual path of the text message to the user terminal 2 is replaced by the path of the text message to the user terminal 3" see [0019]).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

I) Claims 1, 2, 6, 9, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Packham in view of Karve (US 2002/0137530; previously cited).

Regarding claim 1, Packham discloses a method to provide short messaging service (SMS) messages to a receiving party ("people with two handsets" see [0021]) associated with a plurality of devices (fig. 1, handsets 2 and 3; see [0019]), the method comprising:

receiving, at a server device (fig. 1, SMSC-SMS/GMSC and [0019]), a SMS message addressed to a first device of the plurality of devices (fig. 1, handset 2);

identifying, by the server device, a second device of the plurality of devices as a preferred device ("using the routing information" see [0019] and fig. 1, handset 3), instead of the first device, to receive for receiving the SMS message, where the second device is identified without sending the SMS message to the first device ("the usual path of the text message to the user terminal 2 is replaced by the path of the text message to the user terminal 3" see [0019]);

formatting, by the server device, the SMS message according to characteristics of the preferred device ("short message… mobile handset" see [0019] and "a computer… text messages received via email" see [0022]); and

sending, by the server device, the formatted message to the preferred device, where sending the formatted message includes sending the formatted message via a pathway that does not include the first device ("the usual path of the text message to the user terminal 2 is replaced by the path of the text message to the user terminal 3" see [0019]).

But in the step of identifying, Packham does not particularly show based on information stored by the receiving party at the server device. However in analogous art, Karve teaches based on information stored by the receiving party at the server device ("allowing the user to define forwarding address lists stored at the SMS center" see [0030]). Since, Packham and Karve are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Packham as taught by Karve in order to provide the important information such as forwarding address list to the server, which would then use the information for forwarding the SMS message, thus improving the reliability of service; and to allow user to change or update the forwarding address lists whenever he/she needs; thus increasing the quality of service.

Regarding claim 2, Karve further discloses the method of claim 1, where:

the preferred device comprises an SMS-compatible device ("mobile handset" see [0019]),

formatting the SMS message includes formatting the message in an SMS format ("a short message service centre SMSC forwards a text message" see [0019]), and

sending the formatted message comprises sending the formatted message to the SMS-capable device ("the usual path of the text message to the user terminal 2 is replaced by the path of the text message to the user terminal 3" see [0019]).

Regarding claim 6, Karve further discloses the method of claim 1, wherein sending the formatted message comprises sending the formatted message to digital companion client software that the receiving party can access via the preferred device (described as "the appropriate programming at the SMS center or by allowing the user to define forwarding address lists stored at the SMS center" see [0033]).

Regarding claim 9, Packham discloses an apparatus to provide short message service (SMS) messages (fig. 1, SMSC-SMS/GMSC and [0019]) to a user ("people with two handsets" see [0021]) associated with a plurality of devices (fig. 1, handsets 2 and 3; see [0019]), the apparatus comprising:

a database to store information ("routing information" see [0019]) identifying a first device of the plurality of devices as a preferred device (fig. 1, handset 3);

a gateway server (fig. 1, SMSC-SMS/GMSC and [0019]) to receive a SMS message identifying a second device of the plurality of devices (fig. 1, handset 2 and see [0019]); and

a SMS server (fig. 1, SMSC-SMS/GMSC and [0019]) to:

implement a server function to identify the preferred device ("using the routing information" see [0019] and fig. 1, handset 3) instead of the second device for receiving the SMS message in response to receiving the SMS message, the preferred device being different than the second device (fig. 1, handsets 2 and 3; see [0019]), where the server functions identifies the preferred device without sending the SMS message to the second device ("the usual path of the text message to the user terminal 2 is replaced by the path of the text message to the user terminal 3" see [0019]);

format the SMS message in accordance with characteristics of the preferred device ("short message… mobile handset" see [0019] and "a computer… text messages received via email" see [0022]), and

send the message to the preferred device, where the SMS server, when sending the formatted message, is further to determine a pathway to the preferred device that does not include the second device ("the usual path of the text message to the user terminal 2 is replaced by the path of the text message to the user terminal 3" see [0019]).

But, Packham does not particularly show a database to store information identifying each device of the plurality of devices. However in analogous art, Karve teaches a database to store information identifying each device of the plurality of devices; ("allowing the user to define forwarding address lists stored at the SMS center" see [0030]). Since, Packham and Karve are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of

Packham as taught by Karve in order to provide the important information such as forwarding address list to the server, which would then use the information for forwarding the SMS message, thus improving the reliability of service; and to allow user to change or update the forwarding address lists whenever he/she needs; thus increasing the quality of service.

Regarding claim 13, Packham discloses the apparatus of claim 12, except where the means for sending the SMS message comprises means for storing messages to a database when the preferred device is not available to receive messages. However in analogous art, Karve teaches where the means for sending the SMS message comprises means for storing messages to a database when the preferred device is not available to receive messages ([0028]-[0029] and [0007]). Since, Packham and Karve are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Packham as taught by Karve in order to allow the user to receive the message whenever he/she is avialable; thus increasing the quality of service.

Regarding claim 17, Packham further discloses the method of claim 16 where the first destination device and the second destination device (fig. 1, handsets 2 and 3; see [0019]) are associated with a receiving party (“people with two handsets” see [0021]).

But in the step of identifying, Packham does not particularly show identifying the second destination device based on a profile associated with receiving party. However in analogous art, Karve teaches identifying the second destination device based on a profile associated with receiving party ("allowing the user to define forwarding address lists stored at the SMS center" see [0030]). Since, Packham and Karve are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Packham as taught by Karve in order to provide the important information such as forwarding address list to the server, which would then use the information for forwarding the SMS message, thus improving the reliability of service; and to allow user to change or update the forwarding address lists whenever he/she needs; thus increasing the quality of service.

II) Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over in view Packham of Karve and further in view of Gopinath (US-2004/0002350).

Regarding claim 3, Packham and Karve discloses the method of claim 1. Both Packham ([0022]) and Karve ([0008]) suggest sending the formatted message to a personal computer and the user is able to retrieve the message. But Packham and Karve do not particularly teach where sending the formatted message comprises sending the formatted message to an e-mail address that the receiving party can access via the preferred device. However in analogous art, Gopinath teaches wherein sending the formatted message comprises sending the formatted message to an e-mail

address that the receiving party can access via the preferred device ([0054]-[0069]). Since, Packham, Karve and Gopinath are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Packham and Karve as taught by Gopinath for purpose of incorporating the internet system with the SMS message system for increasing advantageously the communication services to the users.

III) Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Packham in view of Karve and further in view of Dehlin (US-2004/0203942; previously cited).

Regarding claim 4, Packham and Karve disclose the method of claim 1 except where sending the formatted message comprises sending the formatted message to an instant messenger client that the receiving party can access via the preferred device. However in analogous art, Dehlin teaches where sending the formatted message comprises sending the formatted message to an instant messenger client that the receiving party can access via the preferred device (described as “The reply customized SMS message is translated into a reply instant message” or “SMS message has been identified as an instant message type” see abstract and [0031]). Since Packham, Karve and Dehlin are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Packham and Karve as taught by Dehlin for purpose of “enabling instant messaging on a mobile device” (see Dehlin’s title

and specification).

IV) Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Packham in view of Karve and further in view of Sabo (US-2003/0096626; previously cited).

Regarding claim 5, Packham and Karve disclose the method of claim 1 except where sending the formatted message comprises sending the formatted message as a voice message that the receiving party can access via the preferred device. However in analogous art, Sabo teaches where sending the formatted message comprises sending the formatted message as a voice message that the receiving party can access via the preferred device (described as “SMSC 18 translates the secure SMS message to a voice message, using a text-to-speech translator 24 comprised in the SMSC, and transmits text message 38 as a voice message 40” see [0031]. Since Packham, Karve and Sabo are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Packham and Karve as taught by Sabo for purpose of “in the case of the landline telephone, the translation is preferably to speech in a text-to-speech converter associated with the SMSC” (see Sabo’s specification, para. [0013]).

V) Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Packham in view of Karve and further in view of Fostick (US-2002/0187794; previously cited).

Regarding claim 7, Karve further discloses the method of claim 1 that once the mobile device receives a SMS message, which can be immediately displayed on the display of the mobile device. In either case, the message is stored for when the user desires to read the message. But Packham and Karve do not particularly teach storing messages in a database when the preferred device is not available to receive messages. However in analogous art, Fostick teaches wherein storing messages in a database when the device is not available to receive messages [0007]. Since, Packham, Karve and Fostick are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Packham and Karve as taught by Fostick for purpose of guaranteeing the message delivery.

Regarding claim 10, Karve further discloses the apparatus of claim 9, except where the SMS server is further to store messages to a database when the preferred device is not available to receive messages ([0028]-[0029] and [0007]). However in analogous art, Fostick teaches wherein storing messages in a database when the device is not available to receive messages [0007]. Since, Packham, Karve and Fostick are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the system of Packham and Karve as taught by Fostick for purpose of guaranteeing the message delivery.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Winkler discloses “source user sending text message to the messaging center; source user requesting to redesign request; identifying destination address of the text message by the messaging center; analyzing said message text for detecting keywords or identifying message subject or contex, or identifying message style; selecting multimedia items related to message keywords and text subject according to pre-defined rules and user preferences; merging selected multimedia items with text message; and transmitting converted message to identified destination address of the target user” (see specification).

b) Berndt discloses “On reception of a message for a forwarded-to subscriber, the control device selects via the subscriber-related information one or more terminals via which the forwarded-to subscriber can be reached, and message formats which are compatible with these terminals, converts the message with the aid of conversion modules and forwards it to the respective corresponding telecommunication network interface for transmission to the selected terminals” (see specification).

c) Metso discloses “A Short Message Service Centre (SC) 202 is provided for controlling the routing of SMS messages. A Service Centre 202 may be connected to

several GSM networks 204. Service Centres 202 are connected to GSM networks via one or more Mobile Services Switching Centres (MSC) which act as gateways between the GSM network 204 and the Service Centre 202. The Mobile Service Switching Centres are functionally different for mobile terminated SMS messages and mobile originated SMS messages, and are respectively known as SMS-Gateway MSC (SMS-GMSC) 206 and SMS-Interworking MSC (SMS-IWMSC) 208" (see specification).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY Q. PHAN whose telephone number is 571-272-7924. The examiner can normally be reached on 9AM-7:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Huy Q Phan/
Primary Examiner, Art Unit 2617
Date : 12/15/2009